

## **REMARKS**

### **I. Drawings**

Applicants submit an attached Replacement Sheet as Appendix B. This Replacement Sheet includes an amended Figure 26 and replaces the previous sheet number 28 of 33. Amended Figure 26 includes labels for each box shown in the figure.

### **II. Specification**

The Abstract has been amended so that it is less than 150 words. Applicants also submit an amended paragraph at page 1, line 12, that indicates Application Serial No. 09/421,965 is now abandoned. With respect to the other objections to the specification cited in the Office Action, Applicants are not aware of any rule or statute, nor has the Examiner cited any authority, stating that appendices at the end of the specification or references to a docket number are improper and should be deleted. Applicants have therefore not made these requested amendments to the Specification.

### **III. Claim Objections**

Claim 61 has been amended to read “the third wavelength” instead of “the second wavelength” in line 7.

### **IV. Double Patenting**

Claims 54-85 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-46 of U.S. Patent No. 6,135,965, claims 1-35 of U.S. Patent No. 6,258,576, claims 1-46 of U.S. Patent No. 6,095,982, claims 1-4 of U.S. Patent No. 5,697,373, claims 1-15 of U.S. Patent 5,612,540 and claims 1-13 of U.S. Patent No. 6,241,662.

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 may be used to overcome a rejection based on non-statutory double patenting. Although not appearing in the

information on PAIR for the instant application, Applicants note that terminal disclaimers to U.S. Patent No. 6,258,576; U.S. Patent No. 5,612,540; and U.S. Patent No. 6,241,662 were filed in Preliminary Remarks to this application on November 14, 2003. While Applicants do not believe it necessary in light of the previously-filed terminal disclaimers, Applicants have filed executed terminal disclaimers to U.S. Pat. Nos. 6,258,576; 5,612,540; and 6,241,662 concurrently herewith for the convenience of the Patent Office. Applicants have also filed terminal disclaimers to U.S. Patent No. 6,135,965, U.S. Patent No. 6,095,982, and U.S. Patent No. 5,697,373 concurrently herewith.

Applicants wish to point out to the Patent Office that the face of U.S. Patent No. 6,241,662 (the '662 Patent) lists LifeSpex, Inc. as the assignee. However, the purported assignment to LifeSpex, Inc. for that patent was void, and ownership of that patent has and does lie with Board of Regents, The University of Texas System, as evidenced by the material behind Appendix H. Applicants also note that the description of the Assignee in the Assignment from LifeSpex to the Board of Regents of the University of Texas did not include the word "System". However, as shown in the included Agreed Final Judgment and Permanent Injunction, the owner of the '662 Patent is the Board of Regents, The University of Texas System. Therefore, the '662 Patent and the pending U.S. App. No. 10/688,152 are commonly owned.

Applicants also wish to point out that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. vs. Union Sanitary District*, 20 U.S.P.Q.2d 1392 (Fed. Cir. 1991).

In light of the present terminal disclaimers, the obviousness-type double patenting rejection of claims 54-85 is believed to be overcome, and favorable reconsideration is therefore requested.

### Conclusion

Applicants believe that these remarks fully address all outstanding matters for this application.

It is believed that no fees are required in connection with the filing of this document. However, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the filing of this document, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski Deposit Account No. 50-1212/UTSB:713US/MCB.

Should the Office desire to discuss this case, the Examiner is encouraged to contact the undersigned attorney at (512) 536-3018.

Respectfully submitted,



Chris W. Spence  
Reg. No. 58,806  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
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Facsimile: (512) 536-4598

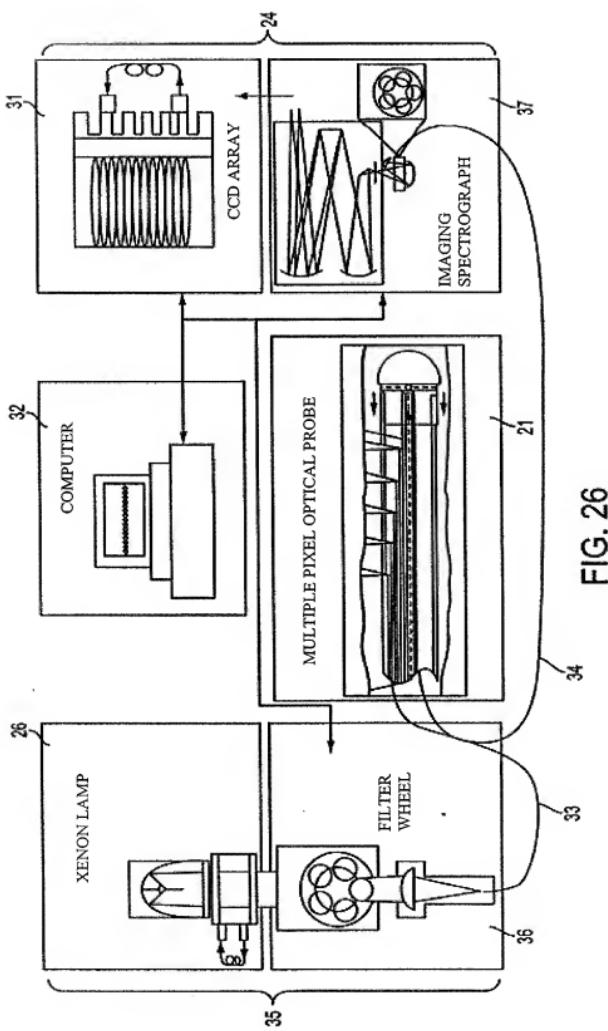
Date: Dec. 6, 2006

## **APPENDIX A**

## ABSTRACT

Fluorescence spectral data acquired from tissues in vivo or in vitro is processed in accordance with a multivariate statistical method to achieve the ability to probabilistically classify tissue in a diagnostically useful manner, such as by histopathological classification. The apparatus includes a controllable illumination device for emitting electromagnetic radiation selected to cause tissue to produce a fluorescence intensity spectrum. Also included are an optical system for applying the plurality of radiation wavelengths to a tissue sample, and a fluorescence intensity spectrum detecting device for detecting an intensity of fluorescence spectra emitted by the sample as a result of illumination by the controllable illumination device. The system also include a data processor, connected to the detecting device, for analyzing detected fluorescence spectra to calculate a probability that the sample belongs in a particular classification. The data processor analyzes the detected fluorescence spectra using a multivariate statistical method. ~~The five primary steps involved in the multivariate statistical method are (i) preprocessing of spectral data from each patient to account for inter patient variation, (ii) partitioning of the preprocessed spectral data from all patients into calibration and prediction sets, (iii) dimension reduction of the preprocessed spectra in the calibration set using principal component analysis, (iv) selection of the diagnostically most useful principal components using a two-sided unpaired student's t test and (v) development of an optimal classification scheme based on logistic discrimination using the diagnostically useful principal component scores of the calibration set as inputs.~~

## **APPENDIX B**



## **APPENDIX C**

RE-  
COPY  
IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
AUSTIN DIVISION

FILED  
CLERK'S OFFICE

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WESTERN DISTRICT OF TEXAS  
U.S. CLERK'S OFFICE

BY: *JK* DEPUTY

BOARD OF REGENTS, THE  
UNIVERSITY OF TEXAS SYSTEM, on  
behalf of THE UNIVERSITY OF TEXAS  
AT AUSTIN,

*Plaintiff.*

CIVIL ACTION NO. A-03-CA-755-SS

v.

LIFESPEX, INC.,

*Defendant.*

**AGREED FINAL JUDGMENT AND PERMANENT INJUNCTION**

Before the Court is the agreement between the plaintiff, Board of Regents of the University of Texas System (the "Board"), on behalf of The University of Texas at Austin ("UT"), and the defendant, LifeSpex, Inc. ("LifeSpex"), to the entry of this Agreed Judgment.

WHEREAS, the Board contends in its complaint that (i) it is the owner of equitable title to U.S. Patent No. 6,241,662 (the "662 Patent"), issued by the United States Patent and Trademark Office on June 5, 2001; (ii) LifeSpex is the holder of bare record title to the '662 Patent and holds such title in constructive trust for the Board; (iii) LifeSpex should transfer any interest it holds, including record title to the '662 Patent, to the Board; and (iv) the assignment to LifeSpex of the technology described in the '662 Patent was erroneous and should be cancelled and rescinded.

WHEREAS, LifeSpex recognizes and acknowledges that (i) it is the holder of bare record title to the '662 Patent and holds such title in constructive trust for the Board; and (ii) the assignment of the '662 Patent to LifeSpex was erroneous.

WHEREAS, LifeSpex represents and warrants that no other agreement affecting the '662 Patent has been or will be made, other than as provided for below;

WHEREAS, UT and LifeSpex stipulate to the dismissal with prejudice of UT's claims for monetary damages. *See FED. R. CIV. P. 41(a)(1)(ii).*

AND WHEREAS, the parties desire to finally resolve any and all matters in dispute between them in relation to this litigation on the terms specified in this Agreed Judgment.

IT IS HEREBY ORDERED, ADJUDGED AND DECREED, that this Court has jurisdiction over the subject matter of this suit and personal jurisdiction of LifeSpex;

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that LifeSpex, and each of its agents, servants and employees, attorneys, and all parties in privity are hereby permanently enjoined from selling, conveying, encumbering, or otherwise alienating any interest in the '662 Patent;

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that the assignment of the '662 Patent, which is Exhibit 1 to this Agreed Judgment is hereby cancelled, and LifeSpex is directed to execute the form of Assignment appended hereto as Exhibit 2 and to take all other and further steps as may be required in order to restore ownership of the '662 Patent to the Board.

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that each party shall bear its attorneys fees and other costs incurred in this lawsuit.

SIGNED and entered this 27<sup>th</sup> day of January 2004.

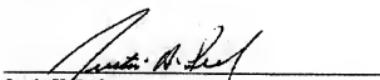
  
\_\_\_\_\_  
UNITED STATES DISTRICT COURT JUDGE

AGREED TO AND APPROVED:



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*Attorneys for Plaintiff Board of The Regents  
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*Attorneys for Defendant LifeSpex, Inc.*



JULY 13, 1999

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20531

\*1010354270\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U. S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320. WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/04/1999

REEL/FRAME: 9934/0120  
NUMBER OF PAGES: 6

BRIEF: ASSIGNMENT OF ASSIGNEE'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR: RICHARDS-KORTUM, REBECCA DOC DATE: 12/31/1998

ASSIGNOR: AGRAWAL, ANANT DOC DATE: 01/21/1999

ASSIGNOR: RITRIS COSTAS DOC. DATE: 02/01/1993

ASSIGNOR: *[Redacted]*

ASSIGNOR: MITCHELL, MICHELE FOLLEN DOC DATE: 04/29/1999

RECEIVED

July 22 1999

- 1 - A. RICHARDSON

## EXHIBIT 1

9934/0120 PAGE 2

ASSIGNEE:

LIFESPPEX, INC.  
11335 NE 112ND WAY, SUITE 175  
KIRKLAND, WASHINGTON 98034

SERIAL NUMBER: 09175232  
PATENT NUMBER:

FILING DATE: 10/20/1998  
ISSUE DATE:

LAWAN FLETCHER, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

S.4.99

Assistant Commissioner for Patents: Pl

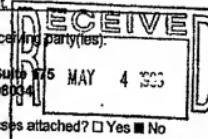
05-11-1999

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Final document

I address of receiving party(ies):

Linceplex, Inc.

11335 NE 112nd Way, Suite 175  
Kirkland, Washington 98034Additional names/addresses attached?  Yes  No

1. Name of conveying party(ies):  
**Rebecca Richards-Kortum**  
**Anant Agrawal**  
**Costas Pitsis**  
**Urs Utzinger**  
**Carrie Brockner**  
**Michele Follen Mitchell**

Additional name(s) attached?  Yes  No

3. Nature of conveyance:  
 Assignment  
 Merger  
 Security Agreement  
 Change of Name  
 Other:

Execution Date: 12/31/98; 1/21/99; 2/1/99; 1/20/99;  
1/21/99; 1/29/99, respectively4. Application number(s) or patent number(s):If this document is being filed with a new application, the execution date of the application is:  
 A. Patent Application No.(s):

09/175,232, filed 10/20/98

B. Patent No.(s):

Additional numbers attached?  Yes  No5. Name/address of party to whom correspondence  
concerning document should be mailed:

**John Land, Reg. No. 29,554**  
**Fish & Richardson P.C.**  
**4225 Executive Square, Suite 1400**  
**La Jolla, CA 92037**

6. Total number of applications/patents involved: 1

7. Total fee (37 CFR 3.41): \$40

 Enclosed  
 Authorized to charge deposit account

8. Deposit account number: 06-1050

If the fee above is being charged to deposit account,  
 a duplicate copy of this cover sheet is attached.  
 Please apply any additional charges, or any credits,  
 to our Deposit Account No. 06-1050.

DO NOT USE THIS SPACE

9. Statement and signature: *To the best of my knowledge and belief, the foregoing information is true and correct and the attached is a true copy of the original document.***John Land, Reg. No. 29,554**

Name of Person Signing

Signature

*Land* 4-30-99

Date

Total number of pages including cover sheet, attachments, and document: 6

05/11/1999 JMG/UTEM 00000075 09175232

01 EC:581

40.00 (P)

Date of Deposit

4/30/99

I hereby certify under 37 CFR 1.8(a) that this correspondence is  
 being deposited with the United States Postal Service as first class  
 mail with sufficient postage on the date indicated above and is  
 addressed to the Assistant Commissioner for Patents, Washington,  
 D.C. 20231.

*Nancy Grant**Nancy Grant*

## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitrис, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpx, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98

Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant Agrawal

Date: 1/26/1999

Costas Pitrис  
Urs Utzinger

Date: \_\_\_\_\_

Carrie Brookner

Date: \_\_\_\_\_

Michele Follen Mitchell

### ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Angela Agrawal, of Austin, Texas; Costes Fliris, of Austin, Texas; Uta Ueninger, of Austin, Texas; Carrie Brooker, of Missouri City, Texas; Michele Folian Mitchell, of Houston, Texas hereby assign to LifeSpec, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 115, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98

Rebecca Richards  
Rebecca Richards-Kortum

Date: 1/21/99

Apantacawal

Date: 1/1

Costas Pittis

Date: 1/20/1993

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Carrie Brookner

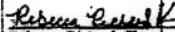
Date: \_\_\_\_\_

Michele Fallon Mitchell

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## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agarwal, of Austin, Texas; Costas Pitsis, of Austin, Texas; Ura Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Pollen Mitchell, of Houston, Texas, hereby assign to LifeSpan, Inc., a corporation having a place of business at 11335 NE 127th Way, Suite 105, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/8/98  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant Agarwal

Date: 9/1/99  
Costas PitsisDate: 1/20/1999

Ura Utzinger

Date: \_\_\_\_\_

Carrie Brookner

Date: \_\_\_\_\_

Michele Pollen Mitchell

### ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitsis of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brooker, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpan, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98

Date:

Date: 1/

Date: 1/1/11

Date: 1/20/1999

Date:

Date: 1/29/99

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Rebecca Richards  
Rebecca Richards-Kortum

Rebecca Richards-Kortum

#### Annual Artival

Costas Pitris

## Ua Utzinger

Census Population

### 1. What is the name of the country you are from?

## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitriz, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpec, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and in successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

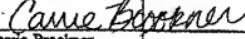
Anant Agrawal

Date: \_\_\_\_\_

Costas Pitriz

Date: \_\_\_\_\_

Urs Utzinger

Date: 1/21/99  
Carrie Brookner

Date: \_\_\_\_\_

Michele Follen Mitchell

7734.1J1

ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitsis, of Austin, Texas; Uta Utinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Pollen Mitchell, of Houston, Texas hereby assign to LifeSpec, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98

Date: \_\_\_\_\_

Date: 1/

Date: 1/20/1999

Date: \_\_\_\_\_

Date: 1/29/99

WITNESS

Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Anant Agrawal

Costas Pitsis

Uta Utinger

Carrie Brookner

Michele Pollen Mitchell

## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agarwal, of Austin, Texas; Cottie Piris, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpectra, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 26, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/21/98

Date: \_\_\_\_\_

Date: 1/1/99Date: 1/20/1999

Date: \_\_\_\_\_

Date: \_\_\_\_\_

7705.121

Rebecca Richards  
Rebecca Richards-Kortum

Anant Agarwal

Urs Utzinger  
Cottie Piris

Urs Utzinger

Carrie Brookner

Michele Follen Mitchell

## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitsis, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpec, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 115, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/21/98

Date: \_\_\_\_\_

Date: \_\_\_\_\_

Date: \_\_\_\_\_

Date: 1/21/99

Date: \_\_\_\_\_

77904.1J1

  
Rebecca Richards-Kortum

Anant Agrawal

Costas Pitsis

Urs Utzinger

  
Carrie Brookner

Michele Follen Mitchell

PATENT

ASSIGNMENT

FOR GOOD AND VALUABLE CONSIDERATION, the receipt, sufficiency and adequacy of which are hereby acknowledged, the undersigned, does hereby:

SELL, ASSIGN AND TRANSFER to the Board of Regents of the University of Texas at Austin. (the "Assignee"), having a place of business at Office of Technology Licensing and Intellectual Property, 3925 West Braker Lane, Suite 1.9A, Mail Code R3500, Austin Texas, 78759, the entire right, title and interest, whether vested or contingent, presently held by the undersigned for the United States and all foreign countries, in and to any and all improvements which are disclosed in United States Letters Patent Application Serial No. 09/175,232 filed on October 20, 1998, and issued June 5, 2001 as U.S. Patent No. 6,241,662, recorded at the U.S. Patent and Trademark Office, Reel 9934, Frame 0120 and is entitled "Acetic Acid as a Signal Enhancing Contrast Agent in Fluorescence Spectroscopy." This sale, assignment and transfer applies to such application and all divisional, continuing, continuation-in-part, substitute, renewal, reissue and all other applications for patent which have been or shall be filed in the United States and all foreign countries on any of such improvements; all original and reissued patents which have been or shall be issued in the United States and all foreign countries on such improvements; and specifically including the right to file foreign applications under the provisions of any convention or treaty and claim priority based on such application in the United States;

AUTHORIZE AND REQUEST the issuing authority to issue any and all United States and foreign patents granted on such improvements to the Assignee;

WARRANT AND COVENANT that the Board of Regents of the University of Texas at Austin is the proper owner, and holds or should hold all rights under and title to, the Patent Application, U.S. Patent No. 6,241,662 and any other patents that may result or relate to the Patent Application and that the prior assignment to LifeSpec, Inc. was made in error and without valid consideration and is therefore void or voidable under Texas law, cancelled and rescinded; and further warrants and covenants that no other assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been or will be made to others by the undersigned;

COVENANT that, when requested and at the expense of the Assignee, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all such improvements; execute all rightful oaths, declarations, assignments, powers of attorney and other papers; communicate to the Assignee all facts known to the undersigned relating to such improvements and the history thereof, and generally do everything possible which the Assignee shall consider desirable for securing, maintaining and enforcing proper patent protection for such improvements and for vesting title to such improvements in the Assignee;

TO BE BINDING on the heirs, assigns, representatives and successors of the undersigned and extend to the successors, assigns and nominees of the Assignee.

(Signature) \_\_\_\_\_ Date: \_\_\_\_\_  
Name: LifeSpex, Inc.

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, 2003,  
personally appeared \_\_\_\_\_ known to me to be the person whose name is  
subscribed to the foregoing instrument and acknowledge to me that (s)he executed the same of (her) his  
own free will for the purposes and consideration therein expressed.

\_\_\_\_\_  
Notary or Consular Officer

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YOU COULD HAVE RECEIVED THIS NOTICE YESTERDAY BY FAX.

Just complete and return the authorization below and you will receive notice of orders and judgments which do not require special mailing requirements, within hours of their entry on WESTERN DISTRICT OF TEXAS cases in which you would normally be noticed. It's FREE and it's FAST. DO NOT SUBMIT MORE THAN ONE AUTHORIZATION. Allow 2 weeks to process.

M. Michelle Muller  
Vinson & Elkins, L.L.P.  
2801 Via Fortuna  
Suite 100  
Austin, TX 78746

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1:03-cv-00755 #7  
16 page(s)  
01/28/04  
tdk

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AUTHORIZATION TO SEND ORDERS AND  
JUDGMENTS BY FACSIMILE TRANSMISSION

The Clerk of Court for the Western District of Texas is authorized to transmit notice of entries of judgments and orders under Fed.R.Civ.P. 77, Fed.R.Crim.P. 49 by facsimile transmission in ANY WESTERN DISTRICT OF TEXAS CASE in which this capability exists, and the undersigned appears as attorney of record. I understand that this electronic notice will be in lieu of notice by mail. The following telephone number is dedicated for facsimile transmissions.

FAX NUMBER : \_\_\_\_\_ Firm Name \_\_\_\_\_

Signature: \_\_\_\_\_ Address: \_\_\_\_\_

Printed Name: \_\_\_\_\_

State Bar No: \_\_\_\_\_ Phone No: \_\_\_\_\_

Mail to: Clerk, Western District of Texas  
Attn: Operations/Quality Control  
727 E. Durango Blvd. - Suite A500  
San Antonio, TX 78206

Or Fax to: 210-472-6587, Attn: Operations/Quality Control

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## RECORDATION FORM COVER SHEET

U.S. Department of Commerce

## PATENTS ONLY

Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original document or copy thereof.

## 1. Name of conveying party(ies):

Rebecca Richards-Kortum, Michele Follen, Urs Utzinger, Carrie Brookner, Anant Agrawal, and Costas Pitris

Additional name(s) of conveying party(ies) attached?  Yes  No

## 3. Nature of conveyance:

Assignment  Merger  
 Security Agreement  Change of Name

 Other Declaration regarding ownership of patent

Execution Date: Assignment - 06/05/03, 05/22/03, 05/22/03, 05/29/03, 05/23/03, 10/06/03; Declaration - 10/14/03

## 2. Name and address of receiving party(ies):

Name: Board of Regents, The University of Texas System

Street Address: 201 West 7<sup>th</sup> Street

City: Austin State: Texas Zip: 78701

Additional name(s) & address(es) attached?  Yes  No

## 4. Application number(s) or registration number(s):

If this document is being filed together with a new application, the execution date of the application is:

## A. Patent Application No.(s):

## B. Patent No.(s):

6,241,662

Additional numbers attached?  Yes  No

## 5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Michael C. Barrett  
 FULBRIGHT & JAWORSKI, L.L.P.  
 600 Congress Avenue, Suite 2400

City: Austin State: Texas Zip: 78701

6. Total number of applications and patents involved: 17. Total fee (37 C.F.R. 3.41) \$ 40.00 Enclosed Authorized to be charged to deposit account  
 if check insufficient or inadvertently omitted8. Deposit account number: 50-1212/TUUT-014US  
 (Attach duplicate copy of this page if paying by deposit account)

## DO NOT USE THIS SPACE

## 9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*

Michael C. Barrett

*Michael C. Barrett*

11/04/2003

Name of Person Signing, Reg. No. 44,523

Signature

Date

Total number of pages including cover sheet, attachments and documents: 9

Mail documents to be recorded with required cover sheet information to:  
 Director of the U.S. Patent and Trademark, Box Assignment, Alexandria, VA 22313-1450

CERTIFICATE OF MAILING  
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Director of the U.S. Patent and Trademark, Box Assignment, Alexandria, VA 22313-1450, on the date below.

November 4, 2003

Date

*Michael C. Barrett*

Michael C. Barrett

Assignment of Rights, Title and Interest in Invention

(Multiple inventors; single assignee)

Docket No. TUUT:014

FOR GOOD AND VALUABLE CONSIDERATION, the receipt, sufficiency and adequacy of which are hereby acknowledged, WE the undersigned, do hereby:

SELL, ASSIGN AND TRANSFER to Board of Regents, The University of Texas System, (the "Assignee"), having an address of 201 W. 7th St., Austin, Texas 78701, the entire right, title and interest in and to any and all inventions which are disclosed in United States Patent Number 6,241,662 (Application Serial No. 09/175,232, filed on October 20, 1998), which issued on June 5, 2001, and is entitled "Acetic Acid as a Signal Enhancing Contrast Agent in Fluorescence Spectroscopy", such application and all divisional, continuing, substitute, renewal, reissue and all other applications for patent which have been or shall be filed in all foreign countries on any of such inventions; and all original and reissued patents which have been or shall be issued in all foreign countries on such inventions.

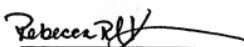
AUTHORIZE AND REQUEST the issuing authority to issue any and all foreign patents granted on such inventions to the Assignee;

WARRANT AND COVENANT its belief that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been or will be made to others by the undersigned, and that the full right to convey the same as herein expressed is possessed by the undersigned:

COVENANT, when requested and at the expense of the Assignee, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all such inventions; execute all rightful oaths, declarations, assignments, powers of attorney and other papers; communicate to the Assignee all facts known to the undersigned relating to such inventions and the history thereof; and generally do everything possible to vest title to such inventions in the Assignee, and for securing, maintaining and enforcing proper patent protection for such inventions;

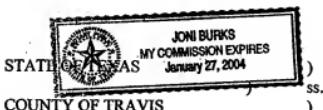
TO BE BINDING on the heirs, assigns, representatives and successors of the undersigned and extend to the successors, assigns and nominees of the Assignee.

(Signature)

 Date 6/5/03

Name:

Rebecca Richards-Kortum



BEFORE ME the undersigned authority, on this 5 day of June 2003, personally appeared Rebecca Richards-Kortum, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

Notary or Consular Officer

## Assignment of Rights, Title and Interest in Invention

(Multiple inventors; single assignee)

Docket No. TUUT:014

(Signature)

Michele Follen Date 5/22/03

Name:

Michele Follen

STATE OF TEXAS

)

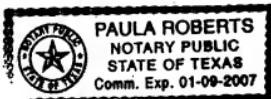
COUNTY OF Harris

)

ss.

BEFORE ME, the undersigned authority, on this 22<sup>nd</sup> day of May, 2003, personally appeared Michele Follen, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

Paula Roberts  
Notary or Consular Officer

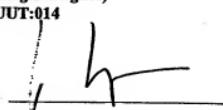
Assignment of Rights, Title and Interest in Invention

(Multiple inventors; single assignee)

Docket No. TUUT:014

(Signature)

Name:



Date 5/22/03

Urs Utzinger

STATE OF ARIZONA

)

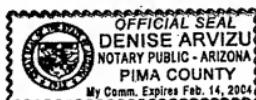
ss.

COUNTY OF Arizona

)

BEFORE ME, the undersigned authority, on this 22nd day of May, 2003, personally appeared Arizona Cancer Center, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

(SEAL)



Notary or Consular Officer

(Signature)

Date \_\_\_\_\_

Name:

Carrie Brookner

STATE OF NEW JERSEY

)

ss.

COUNTY OF \_\_\_\_\_

)

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_, personally appeared \_\_\_\_\_, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature) \_\_\_\_\_ Date \_\_\_\_\_

Name: Urs Utzinger

STATE OF ARIZONA )  
COUNTY OF \_\_\_\_\_ ) ss.  
 )

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, personally appeared \_\_\_\_\_, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

(SEAL) \_\_\_\_\_ Notary or Consular Officer

(Signature) Carrie Brookner Date 5/29/03

Name: Carrie Brookner

STATE OF NEW JERSEY )  
COUNTY OF Somerset ) ss.  
 )

BEFORE ME, the undersigned authority, on this 27th day of May, 2003, personally appeared Carrie Brookner, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

(SEAL) \_\_\_\_\_ Notary or Consular Officer

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature)

Name:



Date 5/23/2003

Anant Agrawal

STATE OF GEORGIA

COUNTY OF FULTON

)  
ss.  
)

BEFORE ME, the undersigned authority, on this 23<sup>RD</sup> day of MAY, 2003, personally appeared ANANT AGRAWAL, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

(SEAL)

  
Notary or Consular Officer

(Signature)

Name:

\_\_\_\_\_ Date \_\_\_\_\_

Costas Pitris

CYPRUS

COUNTY OF \_\_\_\_\_

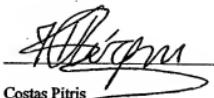
)  
ss.  
)

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_, personally appeared \_\_\_\_\_, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature)

Name:

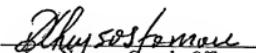
  
Costas Pitrис

Date 10/6/2003

CYPRUS )  
COUNTY OF \_\_\_\_\_ )  
ss. )

BEFORE ME, the undersigned authority, on this 10<sup>th</sup> day of June, 2003, personally appeared Costas Pitrис, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

  
Kyriacos Tsiarmis  
Notary or Consular Officer  
President of the Community  
of Aglandia-Nicosia-Cyprus



10/6/2003  
Tel. 22339638

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*In re* Patent of:

Richards-Kortum, *et al.*

U.S. Pat. No.: 6,241,662

Filed: October 20, 1998

For: ACETIC ACID AS A SIGNAL  
ENHANCING CONTRAST AGENT IN  
FRUORESCENCE SPECTROSCOPY

Atty. Dkt. No.: UNI918/75009

**DECLARATION OF CULLEN M. GODFREY**

I, CULLEN M. GODFREY, HEREBY DECLARE AS FOLLOWS:

1. I am Vice Chancellor and General Counsel in the Office of the General Counsel of The University of Texas System ("UT System").
2. The inventors of the above-referenced U.S. Patent ("the '662 patent") were all employees of the University of Texas at Austin, a component institution of UT System at the time that the claimed invention was made. As a term of their employment, all of the inventors were contractually bound by the intellectual property policy of the UT System (see [http://www.utsystem.edu/bor/rules/MasterRRR.htm#\\_Toc49851668](http://www.utsystem.edu/bor/rules/MasterRRR.htm#_Toc49851668)).
3. It is the policy of the Board of Regents of The University of Texas System ("the Board") that intellectual property either related to the individual's employment responsibility, or resulting from activities performed on UT System time, or from using UT System facilities is subject to ownership by the Board. This was the policy of the UT System at the time that the inventors developed the subject matter in the '662 patent. Therefore, because the patented invention was developed as a result of activities relating to the inventors' employment responsibilities, performed on UT System time and through the use of UT System facilities, the invention of the '662 patent was subject to ownership by the Board. By the terms of the

intellectual property policy, the Board effectively asserted its ownership interest in the '662 patent no later than October 20, 1998, the date when the patent application was filed.

4. It is a further policy of the Board, again, to which the inventors were contractually bound by the terms of their employment agreement, that all employees assign the rights to intellectual property and patents to the Board when such creations are subject to ownership by the Board and the Board elects to assert its ownership interest. As stated in ¶3 above, the inventions of the '662 patent were subject to Board ownership, and the Board asserted ownership of these inventions. Dr. Neil Iscoe, Director, Office of Technology Licensing, The University of Texas at Austin, recently confirmed to me that the inventors of the '662 patent, instead of assigning ownership rights to the Board, mistakenly executed an assignment of their right, title and interest in the '662 patent to LifeSpex, Inc., a licensee of The University of Texas at Austin. Thus, when the inventors executed this incorrect assignment, they held no rights in the '662 patent that could be transferred to a third party, and they were not acting as the agent of Board, the rightful owner of the interest. Thus, under Texas law, the assignment to LifeSpex, Inc. should be held to be void.

5. LifeSpex, Inc. was not a subsequent purchaser or mortgagee for any valuable consideration. Thus, the mistaken assignment to LifeSpex, Inc., which is recorded with the United States Patent and Trademark Office, is not subject to 35 USC §261.

6. The conveyance of all interests in the '662 patent to the Board is reiterated in the assignment by the inventors that is submitted concurrently with this declaration.

7. All statements made in this Declaration of my own knowledge are true and all statements made in this Declaration on information and belief are believed to be true, and these statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001 and may jeopardize the validity of this patent.

Date: October 14, 2003

  
Cullen M. Godfrey

OGC file number 48258 - 383971\_1.DOC

*Bern*